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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:  
STABER et al.

Serial No.: 09/001,565 ) Group Art Unit: 2644

Filed: December 31, 1997 ) Examiner: HAROLD, J.

For: xDSL SPLITTER LINE MODULE FOR  
NETWORK INTERFACE DEVICE )

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**APPELLANT'S BRIEF PURSUANT TO 37 C.F.R. § 1.192**

Dear Sir:

Further to the Notice of Appeal filed April 22, 2002, Appellant's Brief is being submitted in triplicate pursuant to 37 C.F.R. § 1.192. The Examiner is requested and hereby authorized to charge the fee set forth in 37 C.F.R. § 1.17(c) (\$320) for filing a brief in support of the Notice of Appeal to Deposit Account No. 19-2167. The Examiner is also requested and hereby authorized to charge any other fee due in connection with the filing of this paper, including any extension of time fee not already accounted for, to Deposit Account No. 19-2167.

EAT

(1) Real party in interest

The real party in interest is Corning Cable Systems LLC, successor-in-interest to Applicant Siecor Operations, LLC.

(2) Related appeals and interferences

There are no other pending appeals or interferences known to Appellant, Appellant's legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

(3) Status of claims

Claims 1-20 were originally filed in the application with claims 1, 8, 15, and 18 being independent. Claims 2-7 depended from base claim 1. Claims 9-14 depended from base claim 8. Claims 16 and 17 depended from base claim 15. Claims 19 and 20 depended from base claim 18. By the Amendment filed August 24, 2001, claims 3, 4, 9, 10, and 19 were canceled and claims 1, 6, 8, 12, 14, 15, 18, and 20 were amended. Accordingly, claims 1, 2, 5-8, 11-18, and 20 are pending and appealed. A complete listing of the pending and appealed claims in clean form is attached to this Brief as Appendix A.

(4) Status of amendments

An Amendment After Final pursuant to 37 C.F.R. § 1.116 was filed on February 21, 2002, in response to the Final Office Action mailed November 21, 2001. The Amendment After Final argued the outstanding claim rejections under 35 U.S.C. § 103(a) without amendment to the pending claims. The Examiner mailed an Advisory Action on March 19, 2002, indicating that the Amendment After Final fails to place the application in condition for allowance for the reasons stated in the Office Action dated November 21, 2001.

(5) Summary of the invention

The invention relates to a module that is removably installable in a network interface device (NID). The module comprises an xDSL splitter circuit that is electrically connected between an outside plant wire pair, for example from a telephone line from a telephone service provider, and two inside wire pairs, for example a Plain Old Telephone Service (POTS) line and a Digital Subscriber Line (DSL) at a subscriber premises. The DSL line transmits multimedia and high-speed data signals over existing twisted-pair telephone lines currently with POTS signals. The term "xDSL" is used in the application to generically refer to different modem technologies for transmitting higher frequency signals (e.g., ADSL, VDSL, etc.) over a twisted-pair telephone line concurrently with a relatively lower frequency signal (e.g., POTS, ISDN, etc.). The terms "first signal" and "second signal" are used to generically refer to at least two different frequency signals transmitted concurrently over a twisted-pair telephone line that are intended to be separated, or split, at the subscriber premises. The term "combined signal" is used to refer to both the first signal and the second signal combined over the twisted-pair telephone line. The term "splitter" is used to refer to a circuit or component (e.g., a low pass filter, a high pass filter, a combination low pass filter and high pass filter, etc.) that separates the first signal from the combined signal (in the case of a low pass filter or high pass filter) or separates both the first signal and the second signal from the combined signal (in the case of a combination low pass filter and high pass filter). Specification at page 2, line 11 through page 3, line 3.

In the past, splitters have typically been housed with xDSL modems. It is desirable, however, in certain network architectures to locate the splitter in the NID. Deregulation requires a demarcation point between the outside plant wire pair and at least the inside wire pair for the POTS line at the subscriber premises. It is sometimes desirable, however, to isolate the inside wire pair for the xDSL line as well. Furthermore, it is desirable for POTS modules to be designed with a demarcation point that eliminates the need for the subscriber to disconnect any terminal wiring. Accordingly, a need exists for a splitter module adapted to be removably mounted in a NID that provides a demarcation point for both the POTS line and the xDSL line at the subscriber premises and does not require the subscriber to disconnect any terminal wiring.

The invention is a splitter module for mounting in a NID and for providing a demarcation point between a pair of outside plant wires carrying a combined signal and a first pair of inside wires carrying a first signal and a second pair of inside wires carrying a second signal. The splitter module comprises an outside plant pair of terminals configured for having the pair of outside plant wires connected thereto. A splitter circuit is housed in the module with a first pair of contacts electrically connected to the outside plant pair of terminals and a second pair of contacts. A first circuit component of the splitter circuit is electrically connected between the first pair of contacts and the second pair of contacts and designed to pass only the first signal from the first pair of contacts to the second pair of contacts. A first jack is located on the module and electrically connected to the second pair of contacts. A first plug is removably located in the first jack to provide a first demarcation point for the first signal. A first inside pair of terminals located on the module is electrically connected to the second pair of contacts through the first demarcation point and configured for having the first pair of inside wires connected thereto. A second inside pair of terminals located on the module is electrically connected to the outside plant pair of terminals so as to receive at least the second signal and is configured for having the second pair of inside wires connected thereto. A second jack is located on the module and electrically connected in series between the outside plant pair of terminals and the second inside pair of terminals. Finally, a second plug is removably located in the second jack to provide a second demarcation point for the second signal.

The invention is better understood with reference to Figures 1-6 of the application, which illustrate a preferred embodiment of the invention. Splitter module (16) is removably mounted in NID (12) alongside conventional POTS line module (14). Splitter module (16) has carrier plate (44) (Fig. 4) mounted over base (42) and circuit board (62) (Fig. 3) having splitter components (64) thereon is carried on the bottom side (56) of carrier plate (44). The top side (58) of carrier plate (42) is divided into POTS section (72) and xDSL section (74). As best depicted in Fig. 6, POTS section (72) has first inside pair of terminals (83) for electrical connection to the first pair of inside wires (32) carrying the first signal (i.e., the POTS signal). POTS section (72) also has first jack (86) that receives removable first plug (84) to provide a first demarcation point (85) for

the first signal. xDSL section (74) has outside plant terminals (98) for electrical connection to the pair of outside plant wires (20) carrying the combined signal. xDSL section (74) further has second inside pair of terminals (103) for electrical connection to the second pair of inside wires (28) carrying the second signal (i.e., the xDSL only signal or the combined signal depending on the type of splitter circuit). xDSL section (74) also has second jack (106) that receives removable second plug (104) to provide a second demarcation point (105) for the second signal. Circuit board (62) has first pair of contacts (25) electrically connected to outside plant terminals (98) and to second jack (106). Circuit component (64) (i.e., a low pass filter) is electrically connected between first pair of contacts (25) and second pair of contacts (29). Second pair of contacts (29) are electrically connected to first jack (86). Thus, only the lower frequency first signal (i.e., POTS signal) passes from the first pair of contacts (25) through the circuit component (64) and the first jack (86)/first plug (84) to the first pair of inside wires (32). The second signal (i.e., xDSL only signal or combined signal) passes directly from the first pair of contacts (25) (or the outside plant terminals (98)) to the second jack (106)/second plug (104) to the second pair of inside wires (28). Specification at page 8, line 2 through page 12, line 18.

#### (6) Issues

The issues presented for review by this appeal are:

- (I) Claims 1, 5, 8, 11, and 13-18 stand rejected under 35 U.S.C. § 103(a) as being obvious over Collins et al. (US 4,910,770) in view of Russell et al. (US 5,757,803). Office Action dated November 21, 2001, at para. 1; and
- (II) Claims 1, 2, 5-8, 11-18, and 20 stand rejected under the judicially created doctrine of obviousness type double patenting over claims 1-29 of Staber et al. (US 6,137,866) in view of well known prior art. Office Action dated November 21, 2001, at para. 4.

#### (7) Grouping of claims

With respect to the first ground of rejection, independent claims 1, 8, 15, and 18 are separately patentable and do not stand or fall together. Dependent claim 5 stands or falls with the

patentability of base claim 1. Dependent claims 11, 13, and 14 stand or fall with the patentability of base claim 8. Dependent claims 16 and 17 stand or fall with the patentability of base claim 15. Dependent claim 20 stands or falls with the patentability of base claim 18.

With respect to the second ground of rejection, independent claims 1, 8, 15 and 18 are separately patentable and do not stand or fall together. Dependent claims 2 and 5-7 stand or fall with the patentability of base claim 1. Dependent claims 11-14 stand or fall with the patentability of base claim 8. Dependent claims 16 and 17 stand or fall with the patentability of base claim 15. Dependent claim 20 stands or falls with the patentability of base claim 18.

(8) Argument

- (I) Rejection of claims 1, 5, 8, 11, and 13-18 under 35 U.S.C. § 103(a) over Collins et al. in view of Russell et al.

A. Applicable Law

35 U.S.C. § 103(a) imposes the requirement that a claimed invention, to be patentable, must be nonobvious over the prior art "...at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains..." A *prima facie* case of obviousness is a procedural tool of examination allocating the burdens of going forward as between the Examiner and Applicant. As set forth at MPEP 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on applicant's disclosure. ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.

Where a *prima facie* case is not established “then without more the applicant is entitled to grant of the patent.” In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1444, 1445 (Fed. Cir. 1992). The USPTO can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would have suggested or taught the claimed invention. In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988). The Supreme Court in Graham v. John Deere Co. set forth the following factors for determining obviousness: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) such secondary considerations as commercial success, long felt but unresolved needs, and failure of others. 383 U.S. 1, 148 USPQ 459 (1966). All evidence, including the secondary considerations, must be weighed before reaching a conclusion on obviousness. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1561, 1 USPQ2d 1593, 1594 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1986). Specificity is paramount and “[p]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Moreover, there must be concrete evidence in the record to support these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ 1693, 1697 (Fed. Cir. 2001); In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, there must be objective evidence of record explaining why one of ordinary skill in the art would have been motivated to select the references and to combine them in the manner proposed by the examiner to render the claimed invention obvious. Id. at 1434.

- B. The rejection of claims 1, 5, 8, 11, and 13-18 under 35 U.S.C. § 103(a) over Collins et al. in view of Russell et al. is improper because the Examiner has failed to establish a *prima facie* case of obviousness.

Pursuant to paragraph 2 of the Office Action dated November 21, 2002, (hereinafter “Office Action”) claims 1, 5, 8, 11, and 13-18 stand rejected under 35 U.S.C. § 103(a) over Collins et al. in view of Russell et al. In particular, the Examiner asserts that Collins et al. discloses a NID comprising a module (43) for providing a demarcation point between a pair of

telephone company wires (37b) and “an *inherent* first and second pair of subscriber wires ... the inherent first pair of wires *for carrying a first signal*, the inherent second pair of wires *for carrying a second signal* and the pair of telephone company wires (37b) *for carrying the combined signal of first and second signals.*” Office Action at page 2-3 (emphasis added).

Collins et al. does not expressly or inherently disclose or suggest a first pair of inside wires for carrying a first signal (i.e., POTS signal) and a second pair of inside wires for carrying a second signal (i.e., an xDSL only signal or combined signal). The Examiner instead asserts that the first and second pair of subscriber wires are inherent “as evidenced by the fact that one of ordinary skill in the art would have recognized that first and second pair of subscriber wires would have been provided to ensure a communication between the [subscriber] terminals (35), the module (43) and the inherent subscriber equipment.” Office Action at page 2. In Collins et al., there is not even a hint of disclosure or a suggestion that the telephone company wires (37b) carry anything other than a conventional telephone (i.e., POTS) signal. Russell et al. discloses a POTS splitter assembly with improved transhybrid loss. Russell et al. does not disclose or suggest that the POTS splitter assembly could be used in a NID to provide a demarcation point for a first pair of inside wires carrying a first signal and a second pair of inside wires carrying a second signal. The Examiner appears to *presuppose* that it would be have been obvious to one of ordinary skill at the time the invention was made to modify the module (43) of the Collins et al. NID to include the POTS splitter assembly of Russell et al. Only then would it be *possible* for one of ordinary skill in the art to recognize that first and second pairs of subscriber wires would be provided to ensure communication between the subscriber terminals (35), the module (43) and the subscriber equipment. The Examiner fails to make any particular finding “as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed,” as required under In re Kotzab, or to provide any “objective evidence of record explaining why one of ordinary skill in the art would have been motivated to select the references and to combine them in the manner proposed by the examiner to render the claimed invention obvious,” as required under In re Lee.

The Examiner further asserts that Collins et al. discloses “a *splitter* circuit (43a), ... with an *inherent* first pair of contacts ... as a point of communication between the terminals (37) and the splitter circuit (43a)...and an *inherent* second pair of contacts...as a point of communication between the splitter circuit (43a) and the terminals (35) ... [the] *splitter* circuit ... designed to pass the *combined signal* from the first pair of contacts to the second pair of contacts.” Office Action at page 3-4 (emphasis added). Contrary to the Examiner’s assertion, Collins et al. does not expressly or inherently disclose or suggest a splitter circuit. In fact, there is not even a hint of a disclosure or a suggestion that the module (43) contains a *splitter* circuit. The Examiner states that the splitter circuit (43a) is “disclosed at column 6, lines 32-34 and exhibited in figure 9.” Office Action at page 3, paragraph (c). However, the cited passage merely discloses that “[s]uitable electrical conductors (54a) and (37a) interconnect jack (54) on module (43) with the telephone circuit (43a) disposed in the module and with respective ones of the terminals (37).” At column 6, lines 22-27, Collins et al. merely discloses that “[t]he jack assembly (54) is located on a removable module (43) which is capable of housing various types of circuits, as evident in FIG. 9, such as Maintenance Termination Units (MTU’s), Remote Isolation Devices (RID’s), and Half-Ringers.” Each of the examples of telephone circuit (43a) expressly disclosed in Collins et al. operates on a telephone line carrying a discrete signal. Since there is no suggestion that the telephone line electrically connected to the telephone company terminals (37) carries a combined signal, there is no reason that one of ordinary skill in the art the time the invention was made would have modified the module (43) of the Collins et al. NID to include the POTS splitter assembly of Russell et al. Instead the Examiner asserts that “one of ordinary skill in the art would have recognized that first pair of contacts would have been provided to [sic] as a point of communication between the terminals (37) and the splitter [sic] circuit (43a)” and “one or ordinary skill in the art would have recognized that second pair of contacts would have been provided to [sic] as a point of communication between the splitter [sic] circuit (43a) and the terminals (35).” Id. Again, the Examiner *presupposes* that it would be have been obvious to modify the module (43) of the Collins et al. NID to include the POTS splitter assembly of Russell et al. and fails to make any particular finding required under In re Kotzab or to provide any objective evidence of record required under In re Lee.

The Examiner admits that Collins et al. “fails to specifically disclose a splitter circuit with a first circuit component designed to pass only the first signal and a second jack and second plug removably inserted therein … to provide a demarcation point for the signal received by the second inside pair of terminals.” Office Action at page 5. The Examiner then “maintains that it was well known in the art to provide a splitter circuit with a first circuit component designed to pass only the first signal *and a second jack and second plug removably inserted therein* … to provide a demarcation point for the signal received by the second pair of inside terminals, *as taught by Russell.*” Id. (emphasis added). In Russell et al., there is not even a hint of a disclosure or a suggestion that the POTS splitter circuit is electrically connected to a first jack and first plug to provide a demarcation point for the first signal, *let alone* to a second jack and second plug to provide a demarcation point for the second signal. Instead, the Examiner asserts that Russell et al. discloses “an inherent second jack as evidenced by the fact that one of ordinary skill in the art would have recognized that a second jack would have been provided for testing of the xDSL communication signal, and an inherent second plug as evidenced by the fact that one of ordinary skill in the art would have recognized that a second plug would have been provided to communicate with the inherent second jack… to provide a demarcation point for the signal received by the inherent inside terminals, as disclosed at column 3, lines 28-30 and exhibited in figure 7.” Office Action at page 6. However, the passage relied on merely states:

“… a splitter operable for splitting the subscriber loop into a first transmission path including a low pass filter which accommodates a continuation of telephone service signal transmissions along the subscriber loop and a second transmission path…

It is inconceivable how the cited passage (or any other portion of the disclosure of Russell et al.) expressly or inherently teaches a second jack and second plug for providing a demarcation point for the second signal. The Examiner has merely cited references which disclose certain of the components of Applicants’ invention while asserting that the missing components of the claimed invention are “well known in the art” (e.g., a splitter circuit with a first circuit component designed to pass only the first signal *and a second jack and a second plug*), or are “inherent” once the combination is made. The Examiner has not provided a scintilla of objective evidence on the record why it would have been obvious to one of ordinary skill in the art to combine the

teachings of the prior art in the first place. Without objective evidence of a teaching, motivation, or suggestion to combine the references, the Examiner has failed to satisfy the burden to establish a *prima facie* case of obviousness.

A *prima facie* rejection for obviousness must be based on evidence relevant to a finding of whether there is teaching, motivation, or suggestion in the prior art to select and combine the references relied on as evidence of obviousness. In re Lee, 61 USPQ2d at 1433. In particular, there must be objective evidence of record explaining why one of ordinary skill in the art would have been motivated to select the references and to combine them in the manner proposed by the Examiner to render the claimed invention obvious. Id. at 1434. The subjective belief of the Examiner “that it was well known in the art to provide … a second jack and second plug removably inserted therein located electrically in series between the outside pair of terminals and the second inside pair of terminals to provide a demarcation point for the signal received by the second inside pair of terminals” and “that one of ordinary skill in the art would have recognized that a second jack would have been provided for testing of the xDSL communication signal” and “that one of ordinary skill in the art would have recognized that a second plug would have been provided to communicate with the inherent second jack” do not satisfy the requirement for “objective evidence of record.” Conclusory statements, such as those listed above, do not fulfill the Examiner’s obligation to provide reasoned findings based on objective evidence of record. See In re Zurko, 258 F.3d at 1385, 59 UPQ2d at 1697 (“deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense’”). These Federal Circuit decisions clearly establish the requirement for the Examiner to provide *objective* evidence on the record explaining *why* one of ordinary skill in the art would have motivated to combine the cited references in the manner proposed by the Examiner. “This factual question of motivation is material to patentability, and could [can] not be resolved on subjective belief and unknown authority.” In re Lee, 1430 USPQ2d at 1434. In the event that the Examiner continues to rely on the above subjective facts, Applicants hereby request the Examiner to support the factual assertions by providing an affidavit of personal knowledge pursuant to 37 C.F.R. § 1.104(d)(2).

Independent claims 1, 8, 15, and 18 each recite a splitter circuit (xDSL splitter circuit), a second jack (xDSL jack, RJ-45 jack), and a second plug (RJ-45 plug). In support of the § 103 rejection, the Examiner states:

Regarding the splitter circuit, in a similar field of endeavor, Russell discloses a POTS splitter assembly with improved trans-hybrid loss for digital subscriber loop transmission. Russell further discloses a splitter circuit (14) with a circuit component designed to pass only the plain old telephone service (POTS) signal, as disclosed at column 3, lines 28-30 and exhibited in figure 7.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Collins by specifically providing a splitter circuit with a splitter component designed to pass only the POTS signal, as taught by Russell, for the purpose of separating the POTS signal from the combined POTS signal and high data rate transmission signal provided to the subscriber over the current telephone lines.

Regarding the second jack and the second plug removably inserted therein, Russell further discloses a splitter circuit (14), exhibited in figure 7, further comprising an inherent second jack as evidenced by the fact that one of ordinary skill in the art would have recognized that a second jack would have been provided for testing of the xDSL communication signal, and an inherent second plug as evidenced by the fact that one of ordinary skill in the art would have recognized that a second plug would have been provided to communicate with the inherent second jack that is used for testing of the xDSL communication signal, removably inserted therein located electrically in series between the loop (17) and inherent subscriber terminals, to provide a demarcation point for the signal received by the inherent inside terminals, as disclosed at column 3, lines 28-30 and exhibited in figure 7.

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Collins by providing a second jack and a second plug, removably inserted therein electrically in series between the telephone company pair of terminals and the second inside pair of terminals, as taught by Russell, for the purpose of testing the xDSL communication signal received at the second inside pair of terminals.

Office Action at pages 5-6.

As discussed above, Collins et al. does not disclose a telephone line carrying a combined signal comprising a POTS signal and an xDSL signal. Accordingly, there would be no reason for one of ordinary skill to modify the module (43) to include the splitter circuit taught by Russell et al. Furthermore, doing would not produce the claimed invention because the prior art does not

disclose or suggest a second jack and a second plug for providing a demarcation point for the xDSL signal or the combined signal. Since subscriber terminals (35) are electrically connected to jack (54) by cable (51) having modular plug (52) adapted to be received in jack (54), and electrical conductors (54a) electrically connect the jack (54) with the telephone circuit (43a), substituting the splitter circuit of Russell et al. for the telephone circuit (43a) would result in both the POTS signal and the xDSL signal being conducted to the same subscriber terminals (35). Even if there was a proper teaching, motivation or suggestion in the prior art to combine the references, the teaching of Russell et al. does not rectify the failings of Collins et al. because substituting the splitter circuit disclosed by Russell et al. would not produce the claimed invention without a wholesale reconstruction of the Collins et al. line module to accommodate first and second inside wire pairs carrying different signals and providing discrete demarcation points.

For at least the reasons stated above, the Examiner has failed to establish a *prima facie* case of obviousness regarding the independent claims 1, 8, 15, and 18. The dependent claims stand or fall with the patentability of the base claims. Accordingly, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 1, 5, 8, 11, and 13-18 under 35 U.S.C. § 103(a).

- (II) Rejection of claims 1, 2, 5-8, 11-18, and 20 under the judicially created doctrine of obviousness type double patenting over claims 1-29 of Staber et al. in view of well known prior art.

A. Applicable Law

The doctrine of double patenting seeks to prevent the unjustified extension of patent exclusivity beyond the term of a patent. The public policy behind this doctrine is that:

The public should ... be able to act on the assumption that upon the expiration of the patent it will be free to use not only the invention claimed in the patent but also modifications or variants which would have been obvious to those of ordinary skill in the

art at the time the invention was made, taking into account the skill in the art and prior art other than the invention claimed in the issued patent.

In re Zickendraht, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) (Rich, J., concurring).

MPEP § 804.

A rejection based on non-statutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982) (Double patenting results when the right to exclude granted by a first patent is unjustly extended by the grant of a later issued patent or patents.). “Obviousness-type” double patenting requires rejection of a claim of an application when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent. MPEP § 804(B)(1). A double patenting rejection of the obviousness type is analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. § 103 except that the patent relied upon is available as prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Thus, the analysis supporting an obviousness-type double patenting rejection parallels the analysis employed in a section 103 rejection. In re Braat, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). If the application at issue is the later filed application, only a one-way determination of obviousness is needed to resolve the rejection. Accordingly, the rejection is sustainable only if the invention defined in a claim of the application is an obvious variant of the invention defined in a claim of the patent. See e.g., In re Berg, 46 USPQ2d 1226 (Fed. Cir. 1998). Unless a claimed invention in the application is obvious over a claimed invention in the patent, no double patenting rejection of the obviousness-type should be made. MPEP § 804(B)(1)(a).

- B. The rejection of claims 1, 2, 5-8, 11-18, and 20 is improper because the invention claimed in the application is patentably distinct from the invention claimed in the Staber et al. patent and furthermore because the Examiner has failed to establish a *prima facie* case of obviousness.

Pursuant to paragraph 4 of the Office Action, claims 1, 2, 5-8, 11-18 and 20 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent 6,137,866 in view of well known prior art. The Examiner asserts that although the conflicting claims are not identical, they are not patentably distinct from each other because subject matter claimed in the present application “is drawn to the concept of splitting a combined signal from a telephone company.” Office Action at page 25, para. 4.

The *claims* of the Staber et al. patent are directed to a splitter assembly adapted for mounting *within the premises*. Accordingly, the invention defined in the claims of the patent does not provide a demarcation point between the outside plant wires and the first and second pairs of inside wires. In particular, the claims of the Staber et al. patent do not include many of the limitations of the pending and appealed claims, including *inter alia* the first jack and the first plug *for providing a demarcation point for fault isolation testing of the first signal*, and the second jack and the second plug *for providing a demarcation point for fault isolation testing of the second signal*. The claims of the Staber et al. patent merely define a splitter circuit having specific terminations for use within a premises where it is *impossible* to conduct fault isolation testing of the POTS signal, the xDSL signal, or the combined signal. In contrast, the claims of the application at issue define a splitter module for removably mounting in a NID that provides a demarcation point between the outside plant wires and both the POTS signal and the xDSL or combined signal. Thus, the claims of the application are patentably distinct from the claims of the Staber et al. patent. Furthermore, the Examiner has provided no objective evidence of record explaining why one of ordinary skill in the art would be motivated to combine the invention defined by the claims of the Staber et al. patent with “the well known prior art” to produce the claimed invention. As previously discussed, “common knowledge and common sense are not a substitute for such evidence.” In re Lee at 1435. Thus,

For at least the reasons stated above, the claims of the application and patentably distinct from the claims of the Staber et al. patent and the Examiner has failed to establish a *prima facie* case of obviousness regarding the independent claims 1, 8, 15, and 18. The dependent claims

stand or fall with the patentability of the base claims. Accordingly, Appellant respectfully requests the Board to reverse the Examiner's rejection of claims 1, 2, 5-8, 11-18 and 20 under the judicially created doctrine of obviousness-type double patenting. In the event that the Board affirms the double patenting rejection, Appellant agrees to file a terminal disclaimer in full compliance with 37 C.F.R. 1.130(b) to overcome, and thereby obviate, the rejection.

(9) Appendix

Appendix "A" attached hereto contains a complete listing of the claims involved in this appeal in clean form.

## CONCLUSION

The Examiner has failed to establish a *prima facie* case of obviousness in support of the rejection of the independent claims 1, 8, 15, and 20 over Collins et al. in view of Russell et al. Specifically, the Examiner has failed to provide objective evidence on the record of a teaching, motivation, or suggestion in the prior art for one of ordinary skill in the art at the time the invention was made to combine the references in the manner proposed by the Examiner to produce the claimed invention. The claimed invention is patentably distinct from the invention defined by the claims of the Staber et al. patent and the Examiner has again failed to establish a *prima facie* case of obviousness to support the double patenting rejection. The dependent claims stand or fall with the patentability of the base claims. Thus, all of the pending and appealed claims are patentable. Accordingly, Appellant respectfully requests the Board to REVERSE the Examiner's rejection of the pending and appealed claims on the basis of obviousness and non-statutory obviousness-type double patenting.

Respectfully submitted,



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